



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/270,710	03/16/1999	LAWRENCE F. GLASER	0388-0020	2842

7590

11/06/2002

SIXBEY FRIEDMAN LEEDOM & FERGUSON
8180 GREENSBORO DRIVE
SUITE 800
MCLEAN, VA 22102

EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT

PAPER NUMBER


3626

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No. 09/270,710		Applicant(s) Glaser	
Examiner Alexander Kalinowski		Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 28, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3626

DETAILED ACTION

1. Claims 1-22 are presented for examination. Applicant filed an amendment on 8/22/2001 amending claim 1 and adding claim 22. Applicant further filed a request for continued examination on 3/13/2002. Applicant also filed an amendment on 3/13/2002, amending claims 1-3, 10, 16, 20, and 21. Applicant further filed arguments on 8/28/2002. After careful consideration of Applicant's arguments, the Examiner withdraws the grounds of rejection of claims 1-22 based on 35 USC 103. However, after conducting a new search for prior art, new grounds of rejection using the newly found prior art are established for claims 1-22 based on 35 USC 103 as set forth in detail below.

Response to Arguments

2. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection. The Examiner found Applicant's arguments persuasive with respect to the priority date of the Yamashita reference and withdraws the outstanding grounds of rejection of claims 1-22 based on 35 USC 103. However, the Examiner establishes new grounds of rejection based on a newly found reference in the instant office action as set forth in detail in the next section below.

Claim Rejections - 35 USC § 103

Art Unit: 3626

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/24213 A1, Goldschmitt et al. (hereinafter Goldschmitt) in view of "World Wide Watch" (hereinafter The Mail) and Kamakura et al., Pat. No. 6,047,310.

As per claim 1, Goldschmitt discloses a method of transmitting an advertisement from a sending party to a receiving party (see abstract and Fig. 4) comprising the steps of:

initiating a communication from a user-managed data processing system associated with the sending party (see Fig. 1 and page 8, line 26 - page 9, line 2);

associating a preselected advertisement with said communication within the data processing system associated with the sending party (page 9, lines 8-13)

transmitting said communication with said preselected advertisement therein to the recipient (see abstract)

Goldschmitt does not explicitly disclose

embedding the advertisement within the communication.

However, The Mail discloses transmitting said communication with said preselected advertisement embedded therein to the recipient (i.e. inserting advertisements into user's e-mail messages)(see page 1, abstract). It would have been obvious to one of ordinary skill in the art at

Art Unit: 3626

the time of Applicant's invention to include embedding the advertisement within the communication within the Goldschmitt system in order to provide an alternative source of revenue (page 2, lines 29-33).

Goldschmitt and The Mail do not explicitly disclose associating the preselected advertisement with said communication within the user-managed data processing system.

However, Kamakura discloses associating the preselected advertisement with said communication within the user-managed data processing system (i.e. the processing unit 2 designates the type of commodities and services that the receiver want from the category information ... The distributing unit 3 distributes the advertisement information corresponding to the type to the receiver ... distribution of advertisement information to the receiver terminal by electronic mail ...)(col. 5, lines 11-39). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include associating the preselected advertisement with said communication within the user-managed data processing system as disclosed by Kamakura within the Goldschmitt and The Mail combination for the motivation of distributing to a user (i.e. receiver) advertisement information that the user wishes to receive (col. 5, lines 17-20).

As per claim 2, Goldschmitt discloses the method of claim 1, further comprising the steps of: offering to the sender an option of becoming an advertiser (i.e. offer to provide free email service) and enabling, if the offer is accepted, a procedure within said user managed data

Art Unit: 3626

processing system by which said preselected advertisement is associated with the communication (see abstract).

As per claim 3, Goldschmitt discloses the method of claim 1, wherein the advertisement is associated with at least one of software or hardware operable with the user managed data processing system (i.e. email message or software)(see abstract).

As per claim 4, Goldschmitt discloses the method of claim 1, wherein the communication is at least one of e-mail, facsimile, voice-over-IP, voice-over-Internet, voice mail, video mail, video teleconferencing, and an animated presentation (i.e. email)(see abstract).

As per claim 5, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent for a preselected time period (i.e. between 5:00 PM and 7:00 PM)(page 6, lines 1-11).

As per claim 6, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent up to a pre-selected number of times)(i.e. certain number of times during the day)(page 6, lines 1-11).

Art Unit: 3626

As per claim 7, Goldschmitt discloses the method of claim 1, wherein said preselected advertisement is electronically obtained from a third party data processing system (i.e. advertiser storage data files unit 24)(see Fig. 1 and page 8, lines 14-15).

As per claim 8, Goldschmitt discloses the method of claim 2, wherein the user is compensated for accepting the offer to become an advertiser (i.e. user receives free email)(see abstract).

As per claim 9, Goldschmitt discloses the method of claim 1, wherein the advertisement is at least one of visual and aural (i.e. graphics)(page 9, lines 23-29).

As per claim 10, Goldschmitt does not explicitly disclose the method of claim 2, wherein the advertisement is incorporated in setup software for one of software and hardware on said user managed data processing system.

However, the Examiner takes official notice that it was well known to provide advertisements within setup software for software or hardware in the computer arts. The purpose was to alert the customer of other products owned by the manufacturer that might be of interest to the customer. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 2, wherein the advertisement is incorporated

Art Unit: 3626

in setup software for one of software and hardware within the Goldschmitt system for the motivation stated above.

As per claim 11, Goldschmitt discloses the method of claim 2, wherein means for sending the communication comprises at least one of an e-mail client, a facsimile system, a voice-over-IP system, a voice-over-Internet system, a voice mail system, a video mail client, and a video teleconferencing system (i.e. email)(see abstract).

As per claim 12, Goldschmitt discloses the method of claim 2, further comprising offering to a recipient of the communication and advertisement an option of being an advertiser (see abstract).

As per claim 13, Goldschmitt discloses the method of claim 12, wherein said step of offering to a recipient of the communication and advertisement an option of being an advertiser includes fraud avoidance means for reducing or eliminating fraud associated with the transaction (see abstract).

As per claim 14, Goldschmitt discloses the method of claim 7, wherein said preselected advertisement is electronically obtained from a third party data processing system using the Internet (page 8, lines 5-8).

Art Unit: 3626

As per claim 15, Goldschmitt discloses the method of claim 1, wherein the advertisement is displayed to a recipient during a period of at least one of before, during and after the communication (page 8, lines 10-13 and page 9, lines 1-7).

As per claim 16, Goldschmitt discloses the method of claim 1, wherein the user managed data processing system is at least one of a computer and telephone (see Fig. 1 and col. 8, lines 1-13).

As per claim 17, Goldschmitt discloses the method of claim 2, wherein the advertisement is embedded in the communication by a third party (i.e. email messaging center 18)(page 8, lines 14-25).

As per claim 18, Goldschmitt discloses the method of claim 1 wherein said preselected advertisement is determined at least in part by the recipient's demographic (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

As per claim 19, Goldschmitt discloses the method of claim 18 wherein said demographic is at least one of location, language, gender, age, income, and physical handicap (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

Art Unit: 3626

5. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt in view of Kamakura and Uomini..

As per claim 20, Goldschmitt discloses a method of transmitting an electronic communication including an advertisement from a user managed data processing system associated with a sending party to a data processing system associated with a receiving party (see abstract) comprising the steps of:

transmitting an electronic communication using the data processing system associated with the sending party to the data processing system associated with the recipient (see abstract).

Goldschmitt does not explicitly disclose

transmitting the electronic communication including said advertisement using the user managed data processing system associated with the sending party.

However, Kamakura discloses associating the preselected advertisement with said communication within the user-managed data processing system (i.e. the processing unit 2 designates the type of commodities and services that the receiver want from the category information ... The distributing unit 3 distributes the advertisement information corresponding to the type to the receiver ... distribution of advertisement information to the receiver terminal by electronic mail ...)(col. 5, lines 11-39). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include transmitting the electronic communication including said advertisement using the user managed data processing system associated with the

Art Unit: 3626

sending party as disclosed by Kamakura within Goldschmitt for the motivation of distributing to a user (i.e. receiver) advertisement information that the user wishes to receive (col. 5, lines 17-20).

Goldschmitt and Kamakura do not explicitly disclose

locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the user managed data processing system associated with the sending party;

modifying information stored within said signature file to include an advertisement; and
said electronic communication including said information stored within said signature file including said advertisement.

However, Uomini discloses an electronic messaging system that attaches information to the mail messages (see abstract and col. 1, lines 8-10). A signature block (i.e. context data) is used to transmit information to the recipient and is attached to the sender's message (see col. 5, lines 6-18). Furthermore, Uomini discloses the signature block may contain business information (i.e. advertisement)(col. 5, lines 10-12). The motivation for including an advertisement within the signature block was to attach information to the mail message (col. 1, lines 8-10 and col. 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the data processing system associated with the sending party,

Art Unit: 3626

modifying information stored within said signature file to include an advertisement and said electronic communication including said information stored within said signature file including said advertisement as disclosed by Uomini within the Goldschmitt and Kamakura system for the motivation stated above.

As per claim 21, Goldschmitt does not explicitly disclose the method of claim 20 wherein said signature file is associated with an e-mail client operating on said user managed data processing system associated with the sending party.

However, Goldschmitt discloses attaching preselected advertisements to an email message of a recipient wherein said preselected advertisement is electronically obtained from a third party data processing system (page 8, lines 5-8). The Examiner takes official notice that it was well known in the computer arts to use signature files within user managed data processing systems. The motivation for embedding the advertisements with in a signature file at the third party data processing system allows the system to add advertisements to the portion of the email message that is always present thereby simplifying the efficiency and cost of the system. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 20 wherein said signature file is associated with an e-mail client operating on said data processing system associated with the sending party within the Goldschmitt system for the motivation stated above.

Art Unit: 3626

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt, The Mail and Kamakura as applied to claim 1 above, and further in view of Uomini, Pat. No. 6,018,761.

As per claim 22, Goldschmitt, The Mail and Kamakura do not explicitly disclose the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement.

However, Uomini discloses associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement (see Fig. 2b and 2c). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement within the Goldschmitt, The Mail and Kamakura combination for the motivation of obtaining message context information for the recipient regardless of whether it is provided or not by the sender (col. 1, lines 8-10 and col. 2, lines 56-67).

Art Unit: 3626

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


a. Pat. No. 6,292,789 discloses electronically transmitting bills over a computer network where the message includes an advertisement.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-0040.

Alexander Kalinowski 

11/2/2002


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600